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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,416	08/08/2001	Osamu Yamada	35.G2872	9919
5514	7590	03/08/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			LEE, TOMMY D	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2624

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/923,416	<b>Applicant(s)</b> YAMADA ET AL.	
	<b>Examiner</b> Thomas D. Lee	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15, 18 and 21 is/are allowed.
- 6) ☒ Claim(s) 1-12, 16, 17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20011109</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

3. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 9-12 provide for the use of an image processing method for performing gradation matching, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

Art Unit: 2624

35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9-12, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,345,315 (Shalit).

Regarding claims 9-12 and 20, Shalit discloses an image processing method for performing gradation matching between images formed by a first output unit, which is a monitor (video monitor 20 (Fig. 3)), and a second output unit, which is a printer (dot-by-dot printer 50 (Fig. 3)), which have different gradation-reproduction ranges (monitor has 256 gradation levels (column 7, lines 8-11), whereas dot-by-dot printer inherently has 2 gradation levels (whether a dot is printed or not)), wherein a lightness changing process by said second output unit is operatively associated with the gradation-reproduction range of said second output unit (column 12, lines 21-31), and a contrast changing process by said second output unit is operatively associated with the gradation-characteristic curve of said first output unit (column 12, lines 32-39). The gradation-characteristic curve of said second output unit is set based on the gradation-reproduction range of said second output unit and the gradation-characteristic curve of said first output unit (column 7, lines 12-33; column 9, line 32 – column 10, line 16). A

Art Unit: 2624

recording medium containing a program for implementing the above image processing method is provided (column 9, line 65 – column 10, line 2).

Claim 17 is an apparatus claim comprising means corresponding to the limitations recited in corresponding method claim 12. Such means are provided in Shalit, as set forth above.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-8, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalit in view of U.S. Patent 6,067,406 (Van Hoof et al.).

Regarding claims 1-8 and 19, Shalit discloses an image processing method for performing gradation matching between images formed by a first output unit, which is a

Art Unit: 2624

monitor (video monitor 20 (Fig. 3)), and a second output unit, which is a printer (dot-by-dot printer 50 (Fig. 3)), which have different gradation-reproduction ranges (monitor has 256 gradation levels (column 7, lines 8-11), whereas dot-by-dot printer inherently has 2 gradation levels (whether a dot is printed or not)), said image processing method comprising the step of: setting first-output-unit information on said first output unit, the first-output-unit information being a gradation characteristic of a monitor, which is set by a user, by reading predetermined data (column 9, lines 20-31). A recording medium containing a program for implementing the above image processing method is provided (column 9, line 65 – column 10, line 2).

Shalit acknowledged that distortions of a copy image reproduction may arise from variations in paper type (column 2, lines 51-55), but does not explicitly disclose a method for dealing with such variations. However, Van Hoof et al. disclose automatic calibration for output devices, comprising the steps of setting output-medium information, which is a paper type, for use in an output unit by a user (column 5, lines 59-65); and finding an output-gradation reproduction curve from the output-medium information (column 11, lines 36-45). Van Hoof et al. recognized that in the prior art, when a different type of paper is used in an output device, the device must be recalibrated (column 2, lines 13-25); and provides a solution by storing transfer functions corresponding to different media types, thereby saving a user the time and effort of recalibrating the output device. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Shalit by providing calibration with respect to media types, as disclosed by Van Hoof et al.

Art Unit: 2624

Claim 16 is an apparatus claim comprising means corresponding to the limitations recited in corresponding method claim 1. Such means are provided in the combined teachings of Shalit and Van Hoof et al., as set forth above.

***Allowable Subject Matter***

10. Claims 13-15, 18 and 21 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to disclose or suggest “inputting information for, from among the plurality of gradation images output from said second output unit, selecting a gradation image corresponding to said gradation image output from said first output unit; and setting gradation conversion conditions for said second output unit by using the selected gradation image as a target,” in a method for performing gradation matching between first and second output units having different gradation-reproduction ranges, as recited in base claims 13, 18 and 21.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
March 7, 2005